

REMARKS

Claims 59-84 remain pending in the present application. Claim 78 has been amended. Basis for the amendments can be found throughout the specification, drawings and claims as originally filed.

REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Examiner has rejected Claims 78-80 under 35 U.S.C. §112, second paragraph, alleging them to be indefinite for failing to particularly point and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have amended the typographical errors in Claim 78. Accordingly, Applicants believe Claims 78-80 to be in proper order and respectfully request the Examiner to withdrawn his 35 U.S.C. §112, second paragraph rejection.

REJECTION UNDER 35 U.S.C. §103(a)

The Examiner has rejected Claims 59-63, 65-73 and 75-84 under 35 U.S.C. §103(a) as being unpatentable over Schulz et al. (U.S. Patent No. 5,480,734) in view of Bunyea and Mita. The Examiner alleges that this combination would render Applicants' invention obvious to those skilled in the art.

The Court of Appeals for the Federal Circuit, recently In re Kahn, 78 USPQ2d 1329, at 1335-1336 (CAFC 2006) stated the following:

Most inventions arise from a combination of old elements and each element may often be found in the prior art. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. Rather, to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concluded that it would have been obvious to make the claimed invention. In practice, this requires

that the Board explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. ... When the Board does not explain the motivation or the suggestion or teaching that would have lead the skilled artesian at the time the invention to the claimed combination as a whole, we infer that the Board use hindsight to conclude that the invention was obvious. (Cite Omitted)

...

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Id. at 1336

Here, the Examiner has combined Schulz et al. with Bunyea and Mita. The Examiner, if reviewing each reference as whole which he must, would conclude that each of the references relate to different inventions. The Schulz et al. reference illustrates a rechargeable accumulator. Schulz et al. explains the charging process in that during charging, cooling may occur and be monitored by the charging terminal. This occurs so that overcharging does not occur. See, column 4, lines 59-67 through column 5, lines 1-4. Thus, the Schulz et al. reference is concerned with the charging of a battery on a battery charger.

Bunyea illustrates a latching arrangement. Nowhere does Bunyea disclose any type of mechanism to dissipate heat from a battery pack. Reviewing the teachings of Bunyea as a whole, the Examiner chooses a single element and disregards the rest of the Bunyea teaching. The Examiner fails to provide any reason why one would combine a battery charging device (Schulz et al.) with Bunyea.

The Mita reference illustrates a temperature controlling apparatus for an automotive battery system. These batteries relate to a wet-type of battery which has totally different concerns than the batteries used in a cordless power tool.

The Examiner selects these three references without providing any reasons as to why one of ordinary skill in the art would be motivated to select and combine these references. The Examiner only provides a conclusory statement that the references can be combined. The Examiner has failed to review each reference as a whole and provide reasoning as to why one skilled in the art would combine these references as he suggests. The Examiner's failure to provide such reasoning highlights his hindsight reconstruction of Applicants' claims.

The Examiner has picked and chosen, among isolated elements of each patent, disregarding the patents as a whole and combined these isolated features to allegedly render Applicants' claims obvious. The Examiner has failed to provide any reasoning as to why one skilled in the art would have combined these references. Only through the Examiner's hindsight reconstruction can he conclude that these references would be combined together. Accordingly, the Examiner has blatantly disregarded the Court's application of 35 U.S.C. §103(a).

Accordingly, Applicants believe Claims 59-63, 65-73, and 75-84 to be patentably distinguishable over the Examiner's combination.

The Examiner has rejected Claims 64 and 74 under 35 U.S.C. §103(a) as being unpatentable over the above three references further in view of Miller (U.S. Patent No. 5,343,368). The combination of Miller fails to overcome the deficiencies of the combination of the above three references. Accordingly, Applicants believe Claims 64 and 74 to be patentably distinct over the art cited by the Examiner.

The Examiner has rejected Claims 59-69 and 78-80 on the grounds of nonstatutory obviousness-type double patenting over U.S. Patent No. 6,455,186. Applicants enclose a Terminal Disclaimer to overcome the Examiner's rejection.

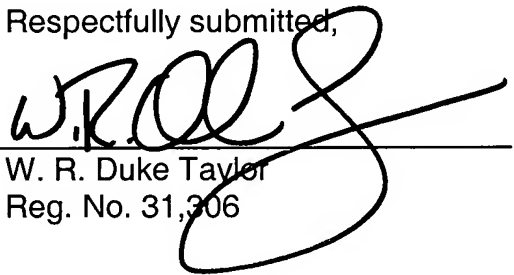
In light of the above amendments and remarks, Applicants submit that all pending claims are in condition for allowance. Accordingly, Applicants respectfully request the Examiner to pass the case to issue at his earliest possible convenience.

Should the Examiner have any questions regarding the present application, he should not hesitate to contact the undersigned at (248) 641-1600.

Respectfully submitted,

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